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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,379	11/15/2001	John Joseph Mascavage III	020375-002710US	2669
20350	7590	10/14/2003	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			CHENCINSKI, SIEGFRIED E	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,379

Applicant(s)

MASCAVAGE ET AL.

Examiner

Siegfried E. Chencinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,9,10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-7, 9-15 & 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilf et al (US Patent 5,899,980).

Re. Claims 1, 10 & 17, Wilf anticipates a method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system, the method comprising steps of:

- receiving transaction information from the vendor site;
- automatically opening a new web browser window for the customer;
- presenting a transaction amount in the new web browser window, whereby the customer can assent to the transaction amount through interaction with the new web browser window;
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Re. Claims 2 & 18, Wilf anticipates the method for authorizing the online purchase between the customer and the vendor site as recited in claim 1 & 17, wherein the new web browser window points away from the vendor site (Col. 2, lines 26-34).

Re. Claims 3 & 11, Wilf anticipates the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, further comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Col. 2, lines 34-47).

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Re. Claims 4 & 12, Wilf anticipates the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, wherein the new web browser window overlays an existing web browser window of the vendor site (Col. 2, lines 3-5, 47-51).

Re. Claims 5, 13 & 19, Wilf anticipates the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1, 10 & 17, wherein the receiving transaction information step triggers the automatically opening step (Col. 2, lines 3-15).

Re. Claims 6, 14 & 20, Wilf anticipates the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1, 10 & 17, further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

Re. Claims 7 & 15, Wilf anticipates the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, further comprising a step of presenting a message to the customer in the new web browser window indicating at least one of the following:

that authorization was canceled by the customer;

that authorization was rejected by a funds transfer system; and

that authorization completed normally (Col. 7, line 58 - Col. 9, line 20).

Re. Claim 9, Wilf anticipates a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilf in view of Kolling et al (US Patent 5,920,847).

Re. Claims 8 & 16, Wilf does not disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claims 1 and 10, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period. However, Kolling discloses a method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claims 1 and 10, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Kolling with the disclosures of Wilf to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction.

Response to Arguments

3. Applicant's arguments filed August 5, 2003 have been fully considered but they are not persuasive.

A. APPLICANT'S ARGUMENTS:

Applicant argues as follows:

.... "Applicant's believe major limitations from claims 1, 10 and 17 are neither taught nor suggested in the Wilf et al. reference. More specifically, Wilf et al. cannot be relied on to teach or suggest: (1) "automatically opening a new web browser for the customer" or (2) "presenting a transaction amounts in the new web browser window." Applicant's respectfully request that the anticipation rejection be withdrawn for these reasons. The Wilf et al. reference is drawn to an online system for ordering goods and services. This reference is silent on how the information might be displayed and does not even

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mention a web browser window. Certainly, the reference does not teach opening a new web browser window for the customer as is generally required by claims 1, 10 and 17. Embodiments of the present invention that open a new web browser window are believed by Applicant's to be advantageous over those that do not because the payment information can be given to a trusted entity in the new web browser window. Users of the Internet are fearful of giving payment payment system with a new web browser window is seen as having a tremendous advantage to those users" (Page 10, 35 U.S.C. section 102 Rejection. Wilf et al., lines 4 – Page 11, line 2).

B. EXAMINER'S RESPONSE:

The Examiner respectfully disagrees with Applicant's argument that the Wilf reference lacks the above two claim elements and affirms the Examiner's original rejection, as repeated above. Both of the disputed claim elements are contained in Wilf, page 1, Col. 2. As Applicant knows, an entire reference serves as the prior art when any component of the reference is cited. The Examiner cited Col. 2, lines 3-15 in the First Action, which is Wilf's first embodiment. Applicant will see that the additional embodiments which immediately follow in the same column contain additional details of Wilf's prior art, including the citation of the additional detailed limitations which represent the two elements Applicant asserts are lacking. These details are contained in Col. 2, line 26 – Col. 3, line 12. The Examiner points out these details below for Applicant's convenience.

Wilf displays his anticipation of Applicant's claimed invention elements in Col. 2, line 54 – Col. 3, line 67, as follows: "... the step of validating includes the steps of automatically receiving by the transaction server from the customer computer station of the transaction details and identification information for identifying the point of sale computer station and the network address of the customer computer station, sending a transaction verification form from the transaction server to the customer computer station, the transaction verification form includes at least the transaction details and information for contacting the network service provider server, entering by the customer in the transaction verification form a confirmation or a denial of the transaction details, sending by the customer computer station of the transaction details and the confirmation or the denial of the

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transaction details from the customer computer station to the network service provider server using the information for contacting the network service provider server included in the transaction verification form, informing the transaction server by the network service provider server of the confirmation or the denial of the transaction details by the customer in the transaction verification form, and instructing the point of sale computer station by the transaction server to supply or deny the goods to the customer in accordance with the confirmation or the denial, respectively, of the transaction details by the customer."

Re. (1) "automatically opening a new web browser for the customer":

Wilf's art contains the components of this disputed claim element as follows:

- automatically: line 2;
- opening a new web browser: lines 2-10. The automatic step triggers a series of steps which include the step of opening a web browser window for the customer through the step of "sending a transaction verification form from the transaction server to the customer computer station, the transaction verification form includes at least the transaction details and information for contacting the network service provider server" (lines 6-10 above). Wilf's automatic step performs the same function as applicant's claim element and is consistent with the role of the "web browser window for the customer" in Applicant's Specification (page 12, para. [61]. Wilf's step fulfills the requirements of a web browser under the definition of "Web Browser" in the Microsoft Computer Dictionary, 4th ed. ("Software that lets a user view HTML documents and access files and software related to those documents ... by providing access to documents on a network, an intranet, or the local hard drive"). Thus, Wilf's user/customer clearly must open a "new web browser window" which contains the next allegedly missing claim element component, the transaction amount.

Re. (2) "presenting a transaction amount in the new web browser window." The above text from Wilf performs Applicant's presentation to the customer/user of the "transaction amount in the new web browser window whereby the customer can assent to the transaction amount through interaction with the new web browser window" according to the above excerpt from Wilf (lines 6 – end, above). The transaction verification amount

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and the acceptance-denial step are included in this text in great detail, particularly in lines 6 – 10 of the above excerpt.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703-308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks Washington D.C. 20231

or faxed to:


(703)305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-8177 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC

October 7, 2003


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600